

REMARKS

This is a reply to the Office Action dated October 15, 2008, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

Status of Claims

After this amendment, claims 1-20 are currently pending. Claims 1, 15 and 19 are independent.

Claims 1, 6-11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,409,733 issued to Conlon et al. ("Conlon") in view of U.S. Patent. No. 5,135,222 issued to Spector. ("Spector"). Claims 2-5 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conlon in view of Spector and further in view of U.S. Patent. No. 5,312,416 issued to Spaeth et al. ("Spaeth"). Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Conlon in view Spector and further in view of U.S. Patent. No. 5,649,021 issued to Matey et al. ("Matey").

Claim Amendments

Claims 1-3 and 11-12 are amended for clarification. New claims 15-20 are added. No new matter is added.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 6-11 and 13

Rejection of claims 1, 6-11 and 13 is respectfully traversed for at least the following reasons, Conlon and Spector, whether considered separately or in combination do not teach, disclose or suggest all of the claimed limitations as amended.

According to MPEP § 2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP § 2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP § 2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Additionally, according to MPEP § 2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Independent claim 1 requires “[a]n easily retrieved biological specimen pouch comprising a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) can receive the biological specimen (9) therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein the string opens and closes the specimen pouch.”

Conlon discloses a specimen retrieval bag that includes a noose to close the specimen bag and spring arms that spread open into a “Y” to deploy (i.e., open) the specimen retrieval bag (Conlon, col. 4, lines 30-36, Fig. 2). In contrast, Applicant’s claimed invention only uses the string (2) to deploy (open) and close the specimen retrieval pouch. Further, Conlon does not

teach, disclose or suggest that the specimen pouch has a discontinuous serration.

Spector discloses a multi-mode playball and is not suited for use in a biological specimen retrieval environment. This is easily seen as the casing and drawstring of Spector is not suitable for insertion into a body. Therefore, Spector is not in the field of endeavor as Applicant's claimed invention (see *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)). Thus, Spector is non-analogous art.

Even though Spector is non-analogous art, the drawstring in Spector cannot open the casing. That is, the casing can be closed by pulling the drawstring in Spector, but the drawstring cannot open a closed casing, which must be manually pulled apart with a person's hands. Moreover, the invention of Conlon does not need the V shaped notches in Spector as the design of the pouch in Conlon is completely different. Therefore, adding the V shaped notches with eyelets to Conlon would change the principle of operation (see MPEP 2143.01 VI, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Further, in Applicant's claimed invention, the string not only can close the specimen pouch, but it also opens the specimen pouch. Moreover, the discontinuous serration reduces the size of the specimen pouch so that the specimen pouch with a large open end could easily pass

through a small surgical cut and diminish the resistance when pulling the specimen pouch out through the small surgical cut. In the prior art, if the open end of a specimen pouch is too large (e.g., the diameter of the open end is greater than 80mm), then the specimen pouch could not pass through a small surgical cut, such as a cut less than 10mm wide. Therefore, in the prior art a cut would need to be enlarged, which causes complications such as larger scars, further suturing, a higher chance of infection, etc.

Even if Spector can legally be combined with Conlon, which Applicant traverses, the combined result does not teach, disclose or suggest “said flexible wall of the open end of *the specimen pouch has discontinuous serration* (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch*” (emphasis added), as required, in part, by independent claim 1.

Further, the assertions made in the Office Action on page 3 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2143 cannot be found. Additionally, since neither Conlon, Spector, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 1 is not obvious over Conlon in view of Spector since a *prima facie* case of obviousness has not been met under MPEP § 2142. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 6-11 and 13, would also not be obvious over Conlon in view of Spector for at least the same

reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 1, 6-11 and 13 is respectfully requested.

Additionally, new independent claim 15 requires, in part, “an open end and a closed end, wherein the specimen retrieval pouch is adapted to receive a biological specimen therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, *the serration includes channels through which a pouch deployment and retrieval string can pass*” (emphasis added). Neither Conlon nor Spector teach, disclose or suggest that a drawstring is a deployment string. Therefore, Conlon in view of Spector does not teach, disclose or suggest *the serration includes channels through which a pouch deployment and retrieval string can pass*” (emphasis added), as required, in part, by new claim 15. Thus, new claim 15 is patentable over the combination of Conlon and Spector for at least these reasons. Dependent claim 16 is patentable over Conlon in view of Spector for at least the same reason.

New claim 17 requires, in part, “the pouch deployment and retrieval string returns to its original shape based on temperature” (emphasis added). New claim 18, which depends from new claim 17, requires, in part, “the *temperature is in the range of 15°C–33°C*” (emphasis added). The drawstrings in Conlon and Spector have nothing to with returning to an original shape based on temperature. Therefore, the combination of Conlon and Spector do not teach the limitations contained in new claims 17 and 18. Thus, new claims 17 and 18 are patentable over

the combination of Conlon and Spector for at least these reasons.

New claim 19 requires, in part, “an open end and a closed end, wherein the specimen retrieval pouch is adapted to receive a biological specimen therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, the *serration includes channels through which a pouch deployment and retrieval string can pass*, wherein *the pouch deployment and retrieval string opens and closes the specimen retrieval pouch*” (emphasis added). As asserted above, Conlon in view of Spector, does not teach disclose or suggest a string opens and closes the specimen retrieval pouch. Therefore, new claim 19 is patentable over Conlon in view of Spector for at least these reasons.

New claim 20 requires, in part, “*the pouch deployment and retrieval string returns to an open state based on temperature of a body*” (emphasis added). As asserted above, the drawstrings of Conlon and Spector do not return to an open state based on temperature. Therefore, Conlon in view of Spector cannot teach, disclose or suggest “*the pouch deployment and retrieval string returns to an open state based on temperature of a body*” (emphasis added), as required, in part, by new claim 20. Therefore, new claim 20 is patentable over Conlon in view of Spector for at least these reasons.

Claims 2-5 and 12

Rejection of claims 2-5 and 12 is respectfully traversed for at least the following reasons,

Conlon, Spector and Spaeth, whether considered separately or in combination, do not teach, disclose or suggest all of the claimed limitations as amended.

Dependent claims 2-5 and 12 either directly or indirectly depend on amended claim 1. As asserted above, the combination of Conlon and Spector, if legally allowed (which Applicant traverses), does not teach, disclose or suggest “said flexible wall of the open end of *the specimen pouch has discontinuous serration* (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch*” (emphasis added), as required, in part, by independent claim 1.

Spaeth discloses a flexible tissue containment sac that includes a rim portion. Spaeth is relied on for disclosing the rim can be withdrawn through a sheath by collapsing and deployed from the sheath by expanding. If the rim feature is combined with the retrieval bag of Conlon, it would change the principle of operation as Conlon includes a drawstring that allows the retrieval bag to be removed from the spring arms. Therefore the teachings of the references are not sufficient to render the claims *prima facie* obvious. Moreover, there would be no need for the Spring arms or the drawstring, and thus the invention of Conlon would simply become the invention of Spaeth. Further, there would be no need to combine the teachings of Spector since the bag would be closed in a different way using the collapsible rim. That is, if the V shaped notches are included on the pouch, since the rim would be pulled into the sheath, the bag would not close with the circumference of the rim moving towards a center point.

Moreover, by viewing the disclosures of Conlon, Spector and Spaeth, one cannot jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2141.01, “[t]he requirement ‘at the time the invention was made’ is to avoid impermissible hindsight.”

‘[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught ... about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.’ W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicant submits that without first reviewing Applicant’s disclosure, no thought whatsoever, would lead to “said flexible wall of the open end of *the specimen pouch has discontinuous serration* (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch*” (emphasis added), as required, in part, by independent claim 1.

Further, the assertions made in the Office Action on page 5 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2143 cannot be found. Additionally, since the combination of Spector and Spaeth with Conlon is not proper, Applicant's amended claim 1 is not obvious over Conlon in view of Spector and further in view of Spaeth since a *prima facie* case of obviousness has not been met under MPEP § 2142. Additionally, the claims that directly or indirectly depend from amended

claim 1, namely claims 2-5 and 12, would also not be obvious over Conlon in view of Spector and further in view of Spaeth for at least the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 2-5 and 12 is respectfully requested.

Claim 14

Rejection of claim 14 is respectfully traversed for at least the following reasons, Conlon, Spector and Matey, whether considered separately or in combination do not teach, disclose or suggest all of the claimed limitations as amended.

Dependent claim 14 directly depends on amended claim 1. As asserted above, the combination of Conlon and Spector, if legally allowed (which Applicant traverses), does not teach, disclose or suggest “said flexible wall of the open end of *the specimen pouch has discontinuous serration* (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch*” (emphasis added), as required, in part, by independent claim 1.

Matey discloses a tool (laparoscope) that is marked with a color not found in an abdomen. The reason Matey does this is so the detector can detect the laparoscope. This is completely different than Applicant’s claimed invention. In Applicant’s claimed invention, a laparoscope is used to guide a physician so that a biological specimen can be placed in the specimen pouch. The coloring of the pouch makes it easy for the physician to differentiate the pouch from the

specimen, which makes it easier for the physician to place the specimen in the pouch and reduces mistakes.

Even if the teachings of Matey are combined with those of Conlon and Spector, the combination would not teach, disclose or suggest “said flexible wall of the open end of *the specimen pouch has discontinuous serration* (1-4); B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch*” (emphasis added), as required, in part, by independent claim 1.

Further, the assertions made in the Office Action on page 7 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2143 cannot be found. Additionally, since neither Conlon, Spector, Matey, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 1 is not obvious over Conlon in view of Spector and further in view of Matey since a *prima facie* case of obviousness has not been met under MPEP § 2142. Additionally, the claim that directly depends from amended claim 1, namely claim 14, would also not be obvious over Conlon in view of Spector and further in view of Matey for at least the same reason.

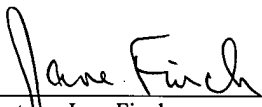
Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claim 14 is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested. If the Examiner feels that a telephone interview may help further the examination of the present application, the Examiner is encouraged to call the undersigned attorney or his associates at the telephone number listed below.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on January 7, 2009 by



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